

claim is unpatentable even though the prior art product was made by a different process. In re Thorpe 777 F. 2d 695, 698, 227 USPQ 994, 996 (Fed. Cir. 1985).

Applicants traverse this rejection and withdrawal thereof is respectfully requested. The Examiner is correct in the statement the patentability of a product-by-process claim depends on the distinctness of the product itself. However, an invention may be defined "in terms of the process." In re Bridgeford 149 USPQ 55 (Ct. Cust. & Pat. App.) The process by which a product is made may be used as a patentable feature defining the invention if the resulting product is novel and unobvious because of the process. Applicants have met their burden of demonstrating that the product of claim 1 is both distinct and unobvious over the product of EP '701.

The product of claim 1 specifically requires that the product be made using a closed mixing means. EP '701 discloses the use of conventional methods, i.e. open mixing, for producing non-photosensitive fatty acid silver salt grains. By using the recited process of claim 1, the resulting product has unique properties compared to the product of EP '701. Tables 1-3 of the specification demonstrate that thermally processed image forming materials of the present invention (Dispersion B through Dispersion H) have unexpected, improved properties, such as a reduced Dmin and high black density and improved coated surface properties compared to the materials of the prior art (Dispersion A). Dispersions B

through H were produced using a closed mixing means in accordance with claim 1, whereas Dispersion A was prepared using an open mixing means. Thus, the product of the present invention, which has been defined, in part, by the process by which it is made, is distinct from and possesses unexpected properties over the product of EP '701.

Claim 10 has been rejected as being obvious over EP '701 combined with WO 97/34196 (WO '196). As discussed above, the products of the present invention are distinct from the products of EP '701 because of the use of a closed mixing means to make the products. The WO '196 reference is relied on for generally teaching the inclusion of nucleating agents. WO '196 fails to teach or suggest the preparation of non-photosensitive fatty acid silver grains using a closed mixing means. As such, WO '196 fails to make up for the deficiencies of EP '701 and the invention of claim 10 is not achieved by combining the references.

Claim 4 has been rejected under 35 U.S.C. §102(a)/103 as being anticipated by or obvious over EP 021 433 or WO 97/341196. On page 4 of the Office Action, the Examiner acknowledges that the references fail to teach the use of a closed mixing means in the preparation of the materials. As discussed above, the use of a closed mixing means results in a different product, which is

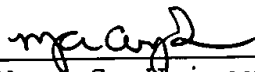
distinct from and possesses unexpected improved properties compared to materials made with an open mixing means. As such, the material of claim 4 is distinct from and not obvious over the materials of EP '433 and WO '196.

As the above-indicated remarks address and overcome the rejection of the claims, withdrawal of the rejections and allowance of the claims are respectfully requested. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, PhD (Reg. No. 40,069) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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